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EXAMINER

PORTER, RACHEL L

| ART UNIT | PAPER NUMBER |
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3626

DATE MAILED: 12/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/444,660

Applicant(s)

PETRUS, EDWARD J.

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Notice to Applicant***

1. This communication is in response to the decision rendered by the Board of Patent Appeals and Interferences mailed 7/21/04 and the Applicant's amendment filed 8/11/04. Claims 1-5 are pending.
2. In view of the Board decision mailed on 7/21/04 and Applicant's amendment filed 8/11/04, PROSECUTION IS HEREBY REOPENED. The grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

***Response to BPAI Decision***

3. In the decision by the Board of Patent Appeals and Interferences (BPAI) mailed 7/21/04 in paper number 26, the rejections of claims 1-5 were reversed. The basis for the reversal of claims 1-5 was, in substance, was the fact that standing prior art rejection was "predicated on speculative assumption as to the meaning of the claims."

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However, the BPAI further explains that its decision regarding the prior art "rests solely on the indefiniteness of the claimed subject and does not reflect on the adequacy of the prior art evidence in support of the §103(a) rejection." (See pages 3-4 of the BPAI decision)

Pursuant to 37 §CFR 1.196, the Board of Patent Appeals and Interferences and Appeals also introduced new grounds of rejection under 35 U.S.C. 112, 1<sup>st</sup> paragraph and 2<sup>nd</sup> paragraph in the 7/21/04 decision. In response to the BPAI decision and the new grounds of rejection raised, the Applicant filed an amendment (dated 8/11/04). A detailed action based upon BPAI decision and the Applicant's 8/11/04 response is provided herein below.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In the decision mailed 7/21/04, the BPAI rejected claims 1-5 for failing to provide adequate written description for the step of adjusting for differences compared to the

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optimal health profile. In the response filed 8/11/04, the Applicant's amended claim 1 to recite a step of "comparing for differences in the individual's health information to standardized health profile based on age, physical activity... and other items in the questionnaire to achieve optimal health and wellness."

However, it is respectfully submitted that the originally filed disclosure does not describe a step of "comparing *for differences* in the individual's health's information to standardized profiles... to achieve optimal health and wellness."

In particular, there are passages directed to comparing "the individual's health information with standardized profiles..." (see page 4, lines 20-21 of the instant specification-received 6/24/2002) and a comparison "with past profiles to determine any changes in nutritonal (*sic*) status." (see page 5, lines 17-18 of the specification-received 6/24/2002) However, there is no direct description of comparing for differences to standardized profiles to achieve optimal health and wellness. As such, it is respectfully submitted that the step of "comparing for differences..." in claim 1, as presently amended, is not adequately described in the instant written specification.

Claims 2-5 inherit the deficiencies of claim 1 through dependency and are also rejected.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 currently recites "comparing for differences in the individual's health information to standardized health profile based on age, physical activity... ***and other items in the questionnaire***" in step 1c) and also recites "generating a computer-implemented dietary supplemented profile...listing the vitamins, minerals...***and other nutritional supplements...***"

The phrases "and other items in the questionnaire" and "and other nutritional supplements" render the claim(s) indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "other items" and "other nutritional supplements"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Also, step c) of claim 1 currently recites "comparing of the questionnaire information by an individual to **a health profile for a person of the individual's age and health history background...**" Step d) goes on to recite "comparing for differences in the individual's health information **to standardized profiles based on age, sex, physical activity...and other items covered in the questionnaire...**" It is unclear to the Examiner whether the "health profile for a person of the individual's age and health history background" is distinct from the "standardized profiles based upon age sex, physical activity, dietary habits, past medical history." Moreover, it is unclear to the Examiner how the steps performed in steps b) and c) are distinct from one another.

Claims 2-5 inherit the deficiencies of claim 1 through dependency and are also rejected.

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**NOTE:** In light of the 112 problems, the examiner is interpreting the claims and applying prior art as best as possible using these interpretations. These interpretations of claim language are for examination purposes only.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 are rejected under 35 U.S.C. §103(a) as being unpatentable over Summerell et al (U.S. Patent No. 5,937,387) in view of Riley (U.S. Patent No. 5,976,568)

In reference to claim 1, Summerell et al teach a method for creating a dietary supplement profile for an individual comprising:

- completing a health questionnaire by an individual; (Figures 4-6; col. 9, lines 15-31)
- comparing the information gathered from the questionnaire to health standard information for a person of the individual's age and health history background (col. 8, line 30-41; line 53-col. 9, line14; col. 11, lines 18-29)
- comparing for differences in the individual's health the information to standardized profiles based on age, sex (gender), physical activity (e.g. energy expenditure),

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dietary habits, and past medical history (See 112, 2<sup>nd</sup> paragraph rejections) (col. 8, line 30-41; line 53-col. 9, line 14; col. 11, lines 18-29; Table 1)

- generating a computer-implemented dietary supplement profile listing vitamins and minerals based on the individual's health information (Figures 19-28)

Summerell et al teach a method and system for providing a dietary supplement profile for an individual in which information from an individual's questionnaire is compared to health standard information based on individuals of comparable age, gender and other health risks including physical activity. (col. 11, lines 18-29) As per the recitation that the comparisons are performed to achieve optimal health and wellness, Summerell discloses a wellness factor array scale that outlines optimal physiological ages that can be achieved with consumption of "optimal levels" of certain nutrients and with changes to various other health factors. (Table 1)

Summerell does not specifically teach that the health standard information (i.e. risk factor data) to which individual's questionnaire information is compared includes standards stored in a database, but Summerell does disclose that a plurality of profile information is stored in various forms in the system. (col. 8, lines 8-60) At the time of the Appellant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Summerell to compare the individual's questionnaire information to standards stored in a database. One would have been motivated to include this feature facilitate data retrieval and health data comparisons and to better assist the user in setting and progressing toward tailored fitness goals that improve overall wellness, as suggested by Summerell. (col. 6, lines 36-52)



Summerell teaches a system/method that obtains individual health data and compares this data to health standard information as explained above. Summerell also discloses a system/method for providing a listing of nutritional/dietary supplements and suggested adjustments to lifestyle habits based on the system's comparison to health standard information (Figures 18-25). However, Summerell does not expressly disclose providing a listing of herbs, enzymes, and amino acids. Riley teaches a method that adjusts for differences in the individual's health profile compared to a health profile and generates a dietary supplement profile based on the individual's health information. (col. 7, line 33-col. 8, line 9; col. 17, lines 30-40, col. 21, lines 35-40). Riley also teaches a method in which the dietary supplement plan includes vitamins, minerals, and herbs. (Table 3)

Summerell and Riley do not expressly disclose that the dietary profile(s) also include(s) enzymes and amino acids, but Riley does teach that the supplement profiles may include other dietary or nutritional compounds. (col. 21, lines 35-40; col. 22, lines 31-38) At the time of the Appellant's invention, it would have been obvious to one of ordinary skill in the art to further modify the system of Summerell in view of Riley to include amino acids and enzymes in the dietary supplement plan for optimal health. As suggested by Riley, one would have been motivated to do this to further ensure adequate intake of nutrients needed for disease prevention and to optimize wellness for individuals with varying lifestyle factors and states of health. (col. 7, lines 33-39; line 65-col. 8, line 9)

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In reference to claim 2, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1.

Summerell et al further teach a method wherein the step of comparing further comprises the adding information provided from a physical examination. (col. 5, lines 62-67) A physician can input test result data (e.g. the individual's blood pressure) into the system. The questionnaire information and physical exam information are compared to health standard data (i.e. health profile data), and these data are used in determining the individual's wellness measurement and making health recommendations (i.e. dietary supplement profile). (col. 5, lines 62-67; see also Table 2; Figures 18-25, esp. figure 24—blood pressure recommendations)

In reference to claim 3, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1.

Summerell et al further teach a method wherein the step of comparing further comprises adding information provided by laboratory studies. (col. 3, lines 19-39, col. 5, lines 62-67) The method disclosed by Summerell et al assesses individual wellness based on several risk factors, health parameters, and test results, including total and HDL cholesterol levels and white blood cell counts. It is respectfully these data items are results that are by laboratory studies. (i.e. blood work/ blood counts.) The questionnaire information and laboratory information are compared to health standard data (i.e. health profile data), and these data are used in determining the individual's wellness measurement and making health recommendations (i.e. dietary supplement profile).

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(col. 3, lines 19-39, col. 5, lines 62-67; see also Table 2; Figures 18-25, esp. figure 23—cholesterol level recommendations)

In reference to claim 4, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1.

Summerell et al teach a method that also includes adding a list of commercially available products that provide the dietary supplements listed in an optimal health profile. (Figures 24-25) In addition to providing nutritional recommendations, the output of the Summerell system also details which products (e.g. fruits, vegetables, artificial vitamin supplements) provide suggested nutrients. It is respectfully submitted the listed food products and artificial nutritional supplements are commercially available products. Moreover, the products included in the list provide nutrients that are included for an optimal health profile (e.g. vitamin C, vitamin E) (as per Riley reference: see Table 3)

In reference to claim 5, Summerell et al and Riley teach the method of providing a dietary supplement profile of claim 1 as explained in the rejection of claim 1.

Summerell et al also teach a method wherein the dietary supplement profile also includes adding recommendations for weight management. (i.e. a weight management plan) (Figure 24). The sample “recommendation details” in the figure suggest a weight loss target for individuals with certain health problems (e.g. high blood pressure) and also explain the health benefits of weight loss and weight maintenance.

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***Response to Amendment***

(A) It is noted that Applicant has responded to the rejection under 35 U.S.C. 112, 2<sup>nd</sup> paragraph and amended the claims in the response filed 8/11/04. However, the amendments made to the claims fail to overcome the rejection of claims 1-5 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph. A more detailed explanation of the rejections have been provided under the *Claim Rejections- 35 USC 112* heading in the current Office Action.

(B) Claims 1-5 were also rejected under 35 U.S.C. 112, 1<sup>st</sup> paragraph. The Applicant did not address this rejection in the Remarks section of 8/11/04, and the amendments provided response do not overcome the written description provided under 35 U.S.C. 112, 1<sup>st</sup> paragraph. A more detailed explanation of the rejections have been provided under the *Claim Rejections- 35 USC 112* heading in the current Office Action.

***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. This action is a **final rejection** and is intended to close the prosecution of this application. Applicant's reply under 37 CFR 1.113 to this action is limited either to an appeal to the Board of Patent Appeals and Interferences or to an amendment complying with the requirements set forth below.

If applicant should desire to file an amendment, entry of a proposed amendment after final rejection cannot be made as a matter of right unless it merely cancels claims or complies with a formal requirement made earlier. Amendments touching the merits of the application which otherwise might not be proper may be admitted upon a showing a good and sufficient reasons why they are necessary and why they were not presented earlier.

A reply under 37 CFR 1.113 to a final rejection must include the appeal from, or cancellation of, each rejected claim. The filing of an amendment after final rejection, whether or not it is entered, does not stop the running of the statutory period for reply to the final rejection unless the examiner holds the claims to be in condition for allowance. Accordingly, if a Notice of Appeal has not been filed properly within the period for reply, or any extension of this period obtained under either 37 CFR 1.136(a) or (b), the application will become abandoned.


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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